

REMARKS

Claims 1-23 are pending in this application and claims 1-23 stand rejected.

Claim Rejections under 35 U.S.C. §112, First Paragraph

Claims 1-23 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Specifically, the Examiner asserts that all the independent claims 1-3, 8, 9 and 13-21 lack enablement. The Examiner specifically discusses claim 1 in which he asserts that “There is no way to know what the “multi-regression equation” is or how to obtain it or how to use it to estimate a price”.

Applicants disagree with the Examiner. As stated in claim 1, data concerning resold vehicle resold within a predetermined period is first extracted. As indicated in paragraph 92 of the specification this data comes from the vehicle type database (13) and the resold vehicle database (14) and may include such items as new vehicle price (paragraph 124), popularity index (paragraph 136), etc. Then in the second step of claim 1, a factor is extracted which has an affect on the vehicle resold price based on correlation analysis using the data extracted in the first step. Finally in the third step a multi-regression equation is obtained from a correlation of the extracted factor and data concerning sold price. This multi-regression equation may then be used to estimate an estimated sold price, an estimated remaining price, or an estimated remaining value rate. (See paragraph 145, 156-158, 167, etc. of the specification).

Therefore, withdrawal of the rejection of claims 1-23 under 35 U.S.C. 112, first paragraph, is respectfully requested.

Claim Rejections under 35 U.S.C. §112, Second Paragraph

Claims 1-7 and 13-20 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner asserts that the preamble of claims 1-7 and 13-20 recite a system while the claims appear directed to a method. Taking the Examiner's comments into consideration claim 1 has been amended so that it is more clearly is directed to a method claim. However, claims 2-7 and 13-20 are intended to be system (apparatus) claims and the applicant does not agree with the Examiner that they are directed to be method claims. However, Applicants do not wish to amend claims 2-7 and 13-20 to include the estimated sold price calculation system (15) so that some structure is provided as is required in a typical system (apparatus) claim. As indicated in paragraph 92, on page 25, lines 9-14 of the specification,

The estimated sold price calculation system 15 obtains a multi-regression equation, a correlation equation or a table having the correlation from the data of the vehicle type database 13 and the resold vehicle database 14, and calculates information concerning estimated sold price, estimated remaining price, or estimated remaining value rate before resale.

Therefore, the estimated sold price calculation system (15) calculates information concerning estimated sold price, estimated remaining price, or estimated remaining value rate before resale as

recited in claims 2-7 and 13-20. Therefore, claims 2-7 and 13-20 have been amended to include the estimated sold price calculation system (15).

Therefore, withdrawal of the rejection of claims 1-7 and 13-20 under 35 U.S.C. 112, second paragraph, is respectfully requested.

Claim Rejections under 35 U.S.C. §101

Claims 21-23 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The Examiner asserts that claims 21-23 are directed toward a computer program with no structure delineated and therefore are considered non-statutory.

As indicated in MPEP §2106 (a)

“Data structures not claimed as embodied in computer-readable media as descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. ... In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory.”

Therefore, claim 21 has been amended to indicate that the computer program is embodied on a computer-readable medium and executable by a computer. Therefore, withdrawal of the rejection of claims 21-23 under 35 U.S.C. §101 is respectfully requested.

Claim Rejections under 35 U.S.C. §102

Claims 8, 9 13-19 and 21 stand rejected under 35 U.S.C. §102(e) as being anticipated by Whitworth (U.S. 6,622,129).

At the outset we must note that the preambles provided in the independent claims are extremely long and detailed in most of the claims in this application. These often lengthy preambles recite features that are definitely not taught by the prior art. However, the Examiner is apparently giving the limitations recited in the preamble no patentable weight. Therefore, the preamble as recited below in claim 15, for example, is not being considered by the Examiner.

“A vehicle resold price analysis system which estimates information concerning sold price, remaining price, or remaining value rate of a vehicle before resale using data concerning resold vehicle such as a maker name, a vehicle type name, vehicle uses, a vehicle shape, a vehicle type grade, authorization model, a model specification number, a classification identification number, a transmission, a drive system, displacement volume, the number of doors, popularly called model, a capacity and burden, engine model, the number of cylinders of engine, an engine mechanism, tire size, turbo and supercharger, roof shape, emission control, body size, automobile-tax classification, a weight tax, an insurance class, a using contract year, expiration year of a using contract, a using contract period, a new vehicle price, the sold price after expiration of using contract, mileage at the time of resale, assessment evaluation at the time of resale...”

Unfortunately, under American law the Examiner need not consider the preamble under certain circumstances. As stated in *In Re Paulsen*, 31 USPQ 2d 1671, 1673 (Fed. Cir. 1994)

“We note at the outset that the term “computer” is found only in the preamble of the claims at issue. The preamble of a claim does not limit the scope of the claim

when it merely states a purpose or intended use of the invention. See *DeGeorge v. Bernier*, 768 F.2d 1318, 1322 n.3, 226 USPQ 758, 761 n.3 (Fed. Cir. 1985). However, terms appearing in a preamble may be deemed limitations of a claim when they "give meaning to the claim and properly define the invention." *Gerber Garment Technology, Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 688, 16 USPQ2d 1436, 1441 (Fed. Cir. 1990) (quoting *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), *cert. denied*, 469 U.S. 857 (1984). Although no "litmus test" exists as to what effect should be accorded to words contained in a preamble, review of a patent in its entirety should be made to determine whether the inventors intended such language to represent an additional structural limitation or mere introductory language."

In the present case it would appear that the Examiner considers the limitations in the preambles of the independent claims to be merely introductory language. Applicants did not intend that the limitations of the preamble to be mere introductory language, but rather intended that they be considered structural limitations. Therefore, the independent claims have been amended so that the limitations of the preambles now appear in the body of the claims.

Regarding the prior art rejection of claims 8, 9 13-19 and 21 as anticipated by Whitworth, the present invention is a vehicle resold price analysis system which estimates information concerning a sold price, a remaining price, or a remaining value rate of a vehicle before resale using data concerning the resold vehicle. This is done using an asset evaluation system (25) which estimates a current price of a vehicle in a using contact period at arbitrary time using data concerning resold vehicle. Further, a remaining value setting system (22) which sets a remaining value concerning new contract vehicle using data concerning resold vehicle. Further, the remaining value setting system (22) sets the remaining value concerning new contract goods using data concerning resold goods and this remaining value setting system (22) sets the remaining value concerning a new

vehicle type using data concerning the resold vehicle.

In addition, the present invention also has a remaining value calculation program (122) used to obtain remaining value data by inputting, in the user application, vehicle type identification information including model specification number, a classification identification number, a vehicle type name, and variation condition information such as a lease period, using period, vehicle registration date, leasing contract date, start-using date, mileage, and ranking; a updating method for this remaining value calculation program; and a user application system using this remaining value calculation program.

Whitworth describes a method of creating an index of residual values for leased vehicles. This method can transfer residual value risk. Further, lease securitization is possible using residual value futures, options, bonds and insurance products. This method uses a Residual Value Index (119) which is a sales volume weighted index of actual residual values for all models sold in a particular model year.

Regarding claim 8, there is no suggestion in Whitworth that mileage or displacement volume are stored as recited in the claim. Therefore, claim 8 has not been amended at this time due to the teachings of Whitworth and applicants wish to traverse the Examiner's grounds of rejection.

Regarding claim 9, claim 9 has been canceled and the rejection of claim 9 is therefore moot.

Regarding claim 13, there is no suggestion in Whitworth of a popularity index determined according to the vehicle type and the mileage being stored. Claim 13 has not been amended at this time due to the teachings of Whitworth and applicants traverse the Examiner's grounds of rejection.

Regarding claim 14, with the inclusion of the limitations of the preamble in the body of the claim, applicants believe that this overcomes the prior art. Therefore, applicants do not believe that claim 14 requires further amendment to overcome the prior art.

Regarding claims 15, 16 and 18, Whitworth does not disclose or suggest using any form of mileage in its calculations. Therefore, claims 15, 16 and 18 have not been amended and applicants traverse the Examiner's grounds of rejection.

Regarding claim 17, Whitworth does not disclose outputting the remaining value profit and loss based on the estimated sold price as recited in claim 17. Therefore, claim 17 has not been amended at this time due to the teachings of Whitworth and applicants traverse the Examiner's grounds of rejection.

Regarding claim 19, with the inclusion of the limitations of the preamble in the body of the claim, applicants believe that this overcomes the prior art. Therefore, claim 19 is allowable over the prior art.

Finally, regarding claim 21, it is applicants opinion that Whitworth does not disclose determining a remaining value from the variation condition information input in the user application, and applicants we do not believe that claim 21 requires further amendment. Therefore, claim 21 is allowable over the prior art.

Claim Rejections under 35 U.S.C. §103

Claims 1-7, 10-12, 20, 22 and 23, as best understood, stand rejected under 35 U.S.C. §103(a) as being unpatentable over Whitworth (U.S. 6,622,129).

Regarding claims 1, 2 and 23, the Examiner admits that Whitworth does not disclose the use of a multi-regression equation, but asserts that this would be obvious. The Examiner is effectively stating that the use of multi-regression equations is “well known” in the art. Therefore, applicants traverse the Examiner’s grounds of rejection and request that the Examiner produce a reference teaching the same as required under MPEP §2144.03.

Regarding claim 3, the Examiner asserts that Whitworth discloses in Figure 3 correlation equations used to obtain information concerning estimated sold price, estimated remaining price, or estimated remaining value rate of vehicle before resale is obtained. However, with the inclusion of the limitations of the preamble in the body of the claim, applicants believe that this overcomes the prior art. Therefore, applicants do not believe that claim 3 requires further amendment.

Regarding claims 4 and 10, the Examiner admits that Whitworth does not teach using mileage from the actual using period. However, the Examiner asserts that this is well known in the art. Applicants wish to traverse the Examiner’s assertions and request that the Examiner produce a reference teaching the same as required under MPEP §2144.03.

Regarding claims 5 and 11, the Examiner asserts that column D of Figure 5 of Whitworth describes a body type such as a sedan. However, claims 5 and 11 are allowable by virtue of their dependence from allowable independent claims. Therefore, applicants do not wish to amend claims

5 and 11 at this time.

Regarding claim 6, the Examiner asserts that Figures 5-7 of Whitworth disclose outputting estimated sold price, estimated remaining price, or estimated remaining value rate of vehicle based on a correlation equation. However, claim 6 is allowable by virtue of its dependence from an allowable independent claim. Therefore, applicants do not wish to amend claim 6 due to this rejection.

Regarding claim 7, contrary to the Examiner's assertions the applicant does not believe that Whitworth describes determining profit-and-loss information. Therefore, applicants wish to traverse the Examiner's grounds of rejection.

Regarding claim 12, Figure 1 of Whitworth does disclose a computer monitor (117). However, claim 12 is allowable by virtue of its dependence upon an allowable independent claim. Therefore, applicants do not wish to amend claim 12 due to this rejection.

Regarding claim 20, the Examiner admits that Whitworth does not describe using a standard deviation, but the Examiner asserts that this would be obvious. The Examiner is effectively stating this the use of a standard deviation is "well known" in the art. Therefore, applicants wish to traverse the Examiner's grounds of rejection and requesting that the Examiner produce a reference teaching the same as required under MPEP §2144.03. Specifically, the reference should disclose "a resold vehicle having a standard deviation within a predetermined range is again selected from the average value of the sold price of the resold vehicle selected by the vehicle spec..." (Emphasis Added).

Regarding claim 22, the Examiner admits that Whitworth does not disclose a secondary retrieval program, but indicates that this information is shown in Figures 5-7 of Whitworth. However, Whitworth does not disclose such items as shape, fuel, displacement volume, vehicle weight, or the maximum burden as recited in claim 22. Therefore, applicants wish to traverse the Examiner's grounds of rejection.

Therefore, withdrawal of the rejection of Claims 1-7, 10-12, 20, 22 and 23 under 35 U.S.C. §103(a) as being unpatentable over Whitworth (U.S. 6,622,129) is respectfully requested.

Conclusion

In view of the aforementioned amendments and accompanying remarks, claims 1-8 and 10-23, as amended, are believed to be patentable and in condition for allowance, which action, at an early date, is respectfully requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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